

## Remarks

### Amendments to the Claims

The amendments to the claims do not add new matter. Claims 2, 27, and 28 are each amended to recite a step of determining whether the test compound has an effect on a symptom of the recited disease in an *in vivo* assay. The specification supports this amendment in the paragraph bridging pages 41 and 42.

### Rejection of Claims 2 and 28 Under 35 U.S.C. § 102(b)

Claims 2 and 28 stand rejected under 35 U.S.C. § 102(b) as anticipated by Fujishige.<sup>1</sup> Applicants respectfully traverse the rejection.

To advance prosecution, claims 2 and 28 are amended to recite a step of determining whether the test compound has an effect on a symptom of the recited disease in an *in vivo* assay. Fujishige does not expressly or inherently describe each of the three steps of claim 2 or claim 28. Fujishige therefore does not anticipate either claim 2 or claim 28.

Please withdraw the rejection.

### Rejection of Claims 2, 27, and 28 Under 35 U.S.C. § 103(a)

Claims 2, 27, and 28 stand rejected under 35 U.S.C. § 103(a) as obvious over Fujishige. Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness, an examiner must make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Fujishige does

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<sup>1</sup> Fujishige *et al.*, *J. Biol. Chem.* 274, 18438-45, 1999.

not teach or suggest that PDE10A would be a useful target for treating the disorders recited in any of claims 2, 27, or 28. Nor does Fujishige teach or suggest determining whether a test compound has an effect on a symptom of cardiovascular disease (claim 2); cancer, liver diseases, diabetes, or kidney diseases (claim 27); or Alzheimer's disease (claim 28) in an *in vivo* assay.

Obviousness requires at least a suggestion of all of the features in a claim. *See CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974). As explained in the response filed January 8, 2008, Fujishige does not contain any expression data which would have led one of ordinary skill in the art to associate PDE10A with any of the diseases recited in claims 2, 27, and 28.

The Final Office Action has not made a *prima facie* case of obviousness. Please withdraw the rejection.

Respectfully submitted,  
**BANNER & WITCOFF, LTD.**  
/Lisa M. Hemmendinger/

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